



06-03-05

IFCW

Dated: _____

Docket No.: 03191/000J838-US0
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

W. Reik et al.

Application No.: 09/982,136 ✓

Confirmation No.: 7044

Filed: October 12, 2001

Art Unit: 3682

For: MOTOR VEHICLE

Examiner: J. K. Smith

REQUEST FOR WITHDRAWAL OF NOTICE OF ABANDONMENT

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Responsive to the Notice of Abandonment mailed May 23, 2005, Applicants respectfully assert that for the following reasons, the withdrawal of the holding of abandonment is in order.

Applicants in the above-identified patent application have received a Notice of Abandonment, dated May 23, 2005, copy enclosed as Exhibit A, advising that the application is abandoned due to Applicants' failure to timely respond to the Office Letter mailed October 13, 2004.

For the reasons set forth below, Applicants believe that the Notice of Abandonment is in error or due to actions by the USPTO and should be withdrawn. More specifically, Applicants respectfully submit that there was no outstanding Office Action that required a formal response by Applicants and thus, the Notice of Abandonment is in error since it refers to the Office Action dated October 13, 2004 as requiring a response by Applicants, thereby forming the basis for the alleged abandonment.

The only communication dated October 13, 2004 is the Examiner's Answer which is enclosed herewith, as Exhibit B. The Examiner's Answer was mailed subsequent to and in response to Applicant's Appeal Brief which was filed on July 8, 2004.

Applicants believe that a recitation of the applicable patent rules governing patent appeals is in order.

37 C.F.R. 41.39 is the applicable patent rule for the Examiner's Answer and states in part:

- (2) An examiner's answer may include a new ground of rejection.
 - (b) If an examiner's answer contains a rejection *designated as a new ground of rejection*, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection: (Emphasis Added)

37 C.F.R. 41.41 is the applicable patent rule section for the filing of a Reply Brief. In part this section states:

- (a)(1) Appellant *may* file a reply brief to an examiner's answer within two months from the date of the examiner's answer. (Emphasis Added)

Moreover, 37 C.F.R. 41.47 is the applicable patent rule section for oral hearings. In part this section states:

- (a) An oral hearing should be requested only in those circumstances in which appellant considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided on the briefs without an oral hearing will receive the same consideration by the Board as appeals decided after an oral hearing.

- (b) *If appellant desires* an oral hearing, appellant must file, as a separate paper captioned "REQUEST FOR ORAL HEARING," a

written request for such hearing accompanied by the fee set forth in § 41.20(b)(3) *within two months* from the date of the examiner's answer or supplemental examiner's answer. (Emphasis Added)

As is clear from the Examiner's Answer contained in Exhibit B, the Examiner's Answer does not contain any new ground of rejection of the claims. In paragraph (10) of the Examiner's Answer, there are two grounds of rejection listed, namely, that claims 1-5, 7-8, and 6-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hardeman et al. in view of Machida et al., as well as claims 9-11 being rejected as being unpatentable over Hardeman et al. in view of Machida et al. and further in view of Burkett. However, the Examiner has indicated that both of these grounds of rejection were set forth in a prior Office Action mailed on January 13, 2004. Thus, it is clear that since these were the only grounds of rejection, there are no new grounds of rejection in the Examiner's answer. Thus, the provisions of 37 C.F.R. 41.39 (2)(b) do not apply in the present situation since there were no new grounds of rejection. As a result, there was non-extendable two month time period for applicants to exercise one of the two stated options.

Contrary to what is stated in the Notice of Abandonment and since the Office letter mailed October 13, 2004 did not require a response, Applicants were under no duty to file a response. Instead and in view of Applicant's decision not to request an oral hearing, the present appeal should have assigned for consideration and decision on the briefs without an oral hearing.

For these reasons, it is respectfully requested that the Notice of Abandonment be withdrawn. Since the alleged abandonment is improper and did not result from any action or lack of action by the Applicants, it is believed that no fee is due with the present request. If this is not the case, it is earnestly requested that the Examiner contact the undersigned.

Dated: June 1, 2005

Respectfully submitted,

By 

Edward J. Ellis

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UNITED STATES PATENT AND TRADEMARK OFFICE

03191/000J838⁸
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,136	10/12/2001	Wolfgang Reik	3191/OJ838	7044
7278	7590	05/23/2005		
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			EXAMINER SMITH, JULIE KNECHT	
			ART UNIT 3682	PAPER NUMBER

TO: W.E. Kupper
ATTY REVIEWED 5/21/05
DATE: 5/21/05

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Notice of Abandonment	Application No.	Applicant(s)	
	09/982,136	REIK ET AL.	
	Examiner Julie K Smith	Art Unit 3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. Applicant's failure to timely file a proper reply to the Office letter mailed on 13 October 2004.
 - (a) A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) No reply has been received.
2. Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) The issue fee and publication fee, if applicable, has not been received.
3. Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) No corrected drawings have been received.
4. The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. The reason(s) below:


JULIE K. SMITH
TECHNOLOGY CENTER 3600

JKS
5/5/05

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

OCT 13 2004

Application Number: 09/982,136

GROUP 3600

Filing Date: October 12, 2001

Appellant(s): REIK ET AL.

MAILED

OCT 13 2004

Edward J. Ellis

GROUP 3600

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/8/04.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1-5 and 7-16 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,267,488	Hardeman et al.	12-1993
4,719,812	Machida et al.	1-1988
5,566,591	Burkett	10-1996

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5, 7-8 and 6-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hardeman et al. (5,267,488) in view of Machida et al. (4,719,812). This rejection is set forth in a prior Office Action, mailed on 1/13/04.

Claims 9-11 rejected under 35 U.S.C. 103(a) as being unpatentable over Hardeman et al. in view of Machida et al., as applied to claims 1-5, 7-8 and 6-12 above, and further in view of Burkett (5,566,591). This rejection is set forth in a prior Office Action, mailed on 1/13/04.

(11) Response to Argument

Appellant first argues that Hardeman et al. lacks a control device to control the clutch in an automated mode. The Examiner agrees that the Hardeman et al. reference lacks this feature, however, the rejections are not based upon 35 USC 102, but rather, are based on 35 USC 103. In order to teach the obviousness of controlling the clutch of Hardeman et al. in an automated mode, the examiner relies upon the teachings of Machida et al. Machida et al. teach to one of ordinary skill in the art the obviousness of operating a clutch in an automated mode (see col. 2, line 34 through col. 3, line 37) wherein at least portions of one of the clutch actuator device and control device are integrated into a carrier element (29, see col. 3, lines 62-68). Thus, it would have been obvious to one of ordinary skill in the art in view of the teachings of Machida et al. to include portions of at least one of the clutch actuator device and the control device in the carrier element of Hardeman et al. in order to automate actuation of the clutch. Appellant's reasoning is further based upon the argument that the elements 11-13 of Machida et al. are on the outside of the transmission. This is incorrect as the elements are located on a carrier element (29) attached to and extending into the transmission casing (28) of Machida et al. (see Fig. 7 and col. 3, lines 38-67).

Next, Appellant argues that the reference to Machida et al. does not address the problems solved by Appellant. Obviousness is not determined solely by whether or not the reference combination solves any stated problem; rather, it is determined by whether or not it would have been obvious to one of ordinary skill in the art to modify the primary reference to achieve the claimed invention. In the instant case, the issue is whether or not it would have been obvious to automate the clutch of Hardeman et al. in view of the teachings of Machida et al. As Machida et al. teach to one of ordinary skill in the art the automating of a clutch in the manner claimed, the reference combination is proper.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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JKS
JKS
October 1, 2004

Conferees:
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Application No. (if known): 09/982,136

Attorney Docket No.: 03191/000J838-US0

Certificate of Express Mailing Under 37 CFR 1.10

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Airbill No. EV 432860673-us in an envelope addressed to:

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on June 1, 2005
Date

B.W. Lee
Signature

B.W. Lee
Typed or printed name of person signing Certificate

Registration Number, if applicable

Telephone Number

Note: Each paper must have its own certificate of mailing, or this certificate must identify each submitted paper.

Request for Withdrawal of Notice of Abandonment (4 pages)
Exhibit A (2 pages)
Exhibit B (5 pages)
Return Postcard

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